

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

EXPRESS MAIL NO. EL717374709US

Applicant : Brian L. Klosterman, et al.
Application No. : to be assigned
Filed : August 27, 2001
Title : SYSTEMS AND METHODS FOR REPLACING TELEVISION
SIGNALS
Docket No. : 47110/JEC/S787

PRELIMINARY AMENDMENT

BOX NEW APPLICATION
Assistant Commissioner for Patents
Washington, D.C. 20231

Post Office Box 7068
Pasadena, CA 91109-7068
August 27, 2001

Commissioner:

Prior to the examination of the above-identified application, please amend the application as follows.

In the Specification:

Please replace the paragraph beginning on page 1 lines 5-8 with the following paragraph:

This application is a continuation of application No. 09/354,762, filed July 29, 1999, which is a continuation of PCT International Application No. PCT/US98/17980, which claims priority of U.S. Provisional application No. 60/057,089, the disclosures of which are hereby incorporated by reference.

REMARKS

Claims 1-28 are currently pending in this application. In the parent application, the Examiner rejected claims 1, 3, 5, 7, 9-12, 14-17 and 19-34 (now rewritten as claims 1-28) under 35 U.S.C. 103(a) as being unpatentable over Wachob (U.S. Patent No. 5,155,591) in view of Alexander et al. (U.S. Patent No. 6,177,931). Applicant requests that Alexander et al. be disqualified as prior art under 35 U.S.C. § 103(c).

Effective November 29, 1999, § 103(c) was amended to add that subject matter that only qualifies as prior art under 35 U.S.C 102(e) and was commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. 103(a). Enclosed is a copy of an assignment and notice of recordations for Alexander et al. and the present application that establish their common ownership. Alexander et al. was assigned to E Guide Inc. and recorded in the Assignment Division of the Patent and Trademark Office on May 1, 2000, on reel 010788, frame 0797. The present application was assigned to Starsight Telecast, Inc. and recorded in the Assignment Division of the Patent and Trademark Office on July 29, 1999, on reel 010139, frame 0844. E Guide Inc. and Starsight Telecast Inc. are wholly owned subsidiaries of Gemstar Corporation. Thus, Alexander et al. and the present application are commonly owned. Alexander et al. must therefore be disqualified as prior art under 35 U.S.C. § 103(c).

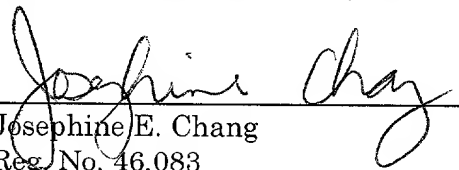
In view of the foregoing remarks, Applicant respectfully requests that this Preliminary Amendment be entered, and that claims pending in this application be allowed.

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By


Josephine E. Chang
Reg. No. 46,083
626/795-9900

JEC/daa

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

This application is a continuation of application No. 09/354,762, filed July 29, 1999, which is a continuation of PCT International Application No. PCT/US98/17980, which claims priority of U.S. Provisional application No. 60/057,089, the disclosures of which are hereby incorporated by reference.

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